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Richard Douglas Kemp

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

PHAM, KHANH B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/603,207
Filing Date: June 25, 2003
Appellant(s): KEMP, RICHARD DOUGLAS

Jon Gordon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/17/2008 appealing from the Office action mailed 6/6/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-12, 16-24, 30, 32-35, 56-69** are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US 6,839,707 B2), hereinafter “**Lee**”.

As per claim 1, Lee teaches at Fig. 1 a system for providing legal information comprising associated items of legal information and content, the system comprising

- “at least one computer and a plurality of user terminal which communicate over a network” at Fig. 1;
- “at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of type of legal information at Col. 1 line 60 to Col. 2 line 54 and Figs. 3, 6, 7;
- “a computer readable medium or media storing programming that cause the at least one computer to access within the at least one database legal information in

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association with to at least one legal topic responsive to a request received from a user terminal” at Col. 2 lines 14-22 and Fig. 6;

- “and cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item” at Col. 7 line 66 to Col. 8 line 49 and Figs. 6-7.

As per claim 2, Lee teaches the system of claim 1, wherein “the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, and news” at Figs. 6-8.

As per claim 3, Lee teaches the system of claim 1, wherein “causing each item of legal information to be display comprises causing each item of legal information to be provided for display in a separate display window by type” at Fig. 6-8.

As per claim 4, Lee teaches the system of claim 3, wherein “the plurality of types of legal information comprises at least two of : “administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials” at Figs. 6-8.

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As per claim 5, Lee teaches the system of claim 3, wherein “the plurality of types of legal information comprises at least: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials” at Figs. 6-8.

As per claim 6, Lee teaches the system of claim 1, wherein “legal topics comprising at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and personal property; communications; media; constitutional; construction; contracts; criminal; education; employment; labor; entertainment; gaming; sports; environmental; estates, trusts, and wills; family; government; elections and politics; government benefits; government contracts; government administration; state government; local government; health; human rights; immigration; insurance; intellectual property; copyrights; patents; trademarks; international; international trade; internet; litigation; litigation administration; appellate procedure; civil procedure; damages and remedies; evidence; mergers and acquisitions; military; natural resources; energy; native populations; professions and occupations; professional licensing; professional responsibility; products liability; real property; science and technology; securities; US federal taxation; state taxation; international taxation; torts; transportation; and workers' rights” at Figs. 6-17.

As per claim 7, Lee teaches the system of claim 1, wherein “the programming causes the at least one computer to:

- “automatically access within the at least one database new legal information responsive to the request while each item of legal information associated with the previously accessed legal information is provided for display on the display device” at Col. 2 lines 7-22 and Fig. 6;
- “provide for display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type” at Fig.7.

As per claim 8, Lee teaches the system of claim 1, wherein “the programming causes the at least one computer to :

- “automatically and periodically access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device” at Col. 2 lines 7-22 and Fig. 6;
- “if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information together with each item of

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legal information associated with the previously accessed legal information all tabulated by type” at Fig. 7.

As per claim 9, Lee teaches the system of claim 1, wherein the programming causes the at least one computer to :

- “automatically and continually access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device” at Col. 2 lines 7-22 and Fig. 6;
- “if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information all tabulated by type” at Fig. 6.

As per claim 10, Lee teaches the system of claim 1, comprising “a plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by legal topic” at Col. 1 line 60 to Col. 2 line 6.

As per claim 11, Lee teaches the system of claim 1, comprising “plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by type of legal information” at Col. 5 lines 35-50 and Fig. 3.

As per claim 12, Lee teaches the system of claim 1, comprising “a plurality of databases for storing the legal information, wherein the legal information is provided by a plurality of sources, and the legal information is stored in separate databases according to the source that provided the information” at Col. 9 lines 25-45.

As per claim 16, Lee teaches the system of claim 1, wherein “the programming causes the at least one computer to display on the display device tabulated by type each item of legal information provided for display”

As per claim 17, Lee teaches the system of claim 16, wherein “each item of legal information displayed on the display device is associated with a selectable link to the associated content, and wherein the programming causes the at least one computer to generate a request to retrieve the associated content from the at least one database in response to selection of a selectable link at the user terminal” at Col. 8 lines 35-48.

As per claim 18, Lee teaches the system of claim 57, wherein “the displayed content comprises a complete version of a document” at Col. 7 lines 5-30.

As per claim 19, Lee teaches the system of claim 57, wherein “the displayed content comprises an abbreviated version of a document” at Col. 5 lines 25-35.

As per claim 20, Lee teaches the system of claim 19, wherein “the abbreviated version of a document comprises a summary of a document” at Col. 7 lines 5-30.

As per claim 21, Lee teaches the system of claim 19, wherein “the abbreviated version of a document comprises at least one redacted portion of a document” at Col. 5 lines 25-35 and Col. 7 lines 5-30.

As per claim 22, Lee teaches the system of claim 16, wherein “the displayed content information comprises at least a partial image of a document” at Col. 7 lines 5-30.

As per claim 23, Lee teaches the system of claim 57, wherein “displayed content and a displayed item of information with which the displayed content is associated are displayed in different display windows” at Figs. 6-17.

As per claim 24, Lee teaches the system of claim 57, wherein “displayed content and displayed item of information with which the displayed content is associated are displayed in different monitor screens” at Col. 7 lines 35-45.

As per claim 30, Lee teaches a method of processing legal information, the method comprising:

- “assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics, at least one identifier associated

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with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information” at Col. 10 lines 34-44 and Figs. 6, 12;

- “formatting the documents according to a protocol; storing the formatted documents in at least one database” at Col. 9 lines 3-65;
- “using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics” at Col. 10 lines 44-65;
- “causing legal information associated with the identified documents to be provided for display on the display device, tabulated by type” at Col. 10 line 65-67 and Fig. 7.

As per claim 32, Lee teaches the method of claim 30, wherein “documents are stored in a plurality of databases” at Col. 9 lines 3-23.

As per claim 33, Lee teaches the method of claim 32, wherein “the documents are stored in the plurality of databases according to at least one of: the topics in relation to which respective document are stored, the type assigned to the documents, and a source of the documents” at Col. 9 lines 3-43.

As per claim 34, Lee teaches the method of claim 30, comprising: “checking formatted documents for compliance with a document receiving protocol; and

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generating a notice of defects automatically upon determination that a checked document does not comply with the protocol” at Col. 9 lines 55-65.

As per claim 35, Lee teaches the method of claim 34, comprising “automatically performing the assigning and formatting steps on the non-complying document” at Col. 9 lines 55-65.

As per claim 56, Lee teaches the system of claim 16, wherein “the programming stored on the computer readable medium or media causes the at least one computer to provide for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal” at Col. 11 lines 12-35 and Fig. 6.

As per claim 57, Lee teaches the system of claim 56, wherein “the programming stored on the computer readable medium or media cause the at least one computer to display on the display device the content provided for display” at Fig. 6.

As per claim 58, Lee teaches a method for providing legal information comprising associated items of legal information and content in a system comprising at least one computer and a plurality of user terminals which communicate over a network, and at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality types of legal information (Figs. 1-3, 6), the method comprising:

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- “the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal” at Fig. 1;
- “the at least one computer providing for display on a display device associated with the user terminal from which the request was received each item of legal information associated with the accessed information, tabulated by type of legal information and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item” at Fig. 1-3, 6.

As per claim 59, Lee teaches the method of claim 58, comprising “the at least one computer displaying on the display device tabulate by type each item of legal information provided for display” at Fig. 6.

As per claim 60, Lee teaches the method of claim 59, comprising “the at least one computer providing for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal” at Col. 11 lines 11-35 and Figs. 6-17.

As per claim 61, Lee teaches the method of claim 60, comprising “the at least one computer displaying on the displayed device the content provided for display” at Figs. 6-17.

As per claim 62, Lee teaches the method of claim 59, wherein “displaying each item of legal information comprises displaying each item of legal information in a separate display window by type” at Fig. 6.

As per claim 63, Lee teaches the method of claim 61, wherein “displaying the content comprises displaying the content in a different display window than each associated displayed item” at Figs. 6-17.

As per claim 64, Lee teaches the method of claim 61, wherein “displaying the content comprises displaying the content in a different monitor screen than each associated displayed item” at Col. 11 lines 25-35 and Figs. 6-17.

As per claim 65, Lee teaches the method of claim 59, wherein “each item of legal information displayed on the display device is associated with a selectable link to associated content, the method comprising generating a request to retrieve the associated content by selection of a selectable link at the user terminal” at Col. 1- lines 55-67 and Fig. 6.

As per claim 66, Lee teaches the method of claim 58, comprising “the at least one computer: automatically accessing within the at least one database new legal information responsive to the request while providing for display each item of legal information associated with the previously accessed legal information; and providing for

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display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type" Col. 2 lines 7-22 and Fig. 6.

As per claim 67, Lee teaches the method of claim 60, comprising the at least one computer: automatically and periodically accessing the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and if new legal information responsive to the request is stored within the at least one database, providing for display on the display device each item of legal information associated with the new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type" at Col. 2 lines 7-22 and Fig. 6.

(10) Response to Argument

A. Claims 1-12, 16-24, 30, 32-35, 56-69 are anticipated by Lee.

1. Claims 1-6, 10-12, 16-24, 56-65, and 68.

(a) Response to Appellant's arguments that Lee fails to teach: "at least one database storing legal information in association with a plurality of legal topics, a plurality of types of legal information, or both".

Appellant argued that "Lee fails to teach or suggest a database storing legal information in association with a plurality of legal topics". The examine respectfully disagrees and respectfully submits that Lee clearly teaches at Col. 2 lines 7-15 that:

"In one aspect, the present invention is a method that includes the steps of receiving and **storing legal/business information in a central database**. The information is organized within the centralized database and reported to a user"

Lee therefore teaches at least one database storing legal information at claimed.

Appellant further argued that "Lee fails to teach or suggest the existence of a plurality of **legal topics**". Appellant's claim 6 provide more detail for "legal topics", which comprise a broad range of topics such as "antitrust", "environmental", "intellectual property", "litigation" . Similarly, Lee teaches the database comprises plurality of libraries storing documents associated with plurality of legal topics such as "antitrust", Intellectual property as seen in Fig. 15, partially reproduced below:

Advanced Search

Select Type of Search

☐ Boolean

☒ Concept

☐ Pattern

☐ Multiple Select

Select Library

Select Section

Select Sub-section

Enter Query

Select Library

☒ GE Corporate

☐ Compliance/Integrity

☐ Human Resources

☐ Legal Productivity

☐ Our Organization

☐ Practice Groups

☐ Antitrust

☐ Environmental

☐ Gov't Business

☐ Ins. Law & Policy

☐ Intellectual Prop.

☐ Litigation

☐ Securities

☐ Sourcing

☐ Quality

☐ Reg'l Components

☐ Asia

☐ Europe

☐ Mexico

☐ Technology

☐ Consumer Law

☐ FG&T

☐ IT & E-Commerce

☐ Insurance

☐ Labor & Emp.

☐ M & A

☐ Services

☐ Tax

☐ Canada

☐ GSRD

☐ South America

FIG. 15

Appellant further argued that Lee fails to teach "a plurality of **types of legal information**". On the contrary, based on Appellant definition of "type of legal information" recited in claims 4-5, Lee teaches at least two different types of legal information such as "news" and "secondary material", as seen in Lee's Fig. 6 below:

GE Legal

Home | Inside GE | Content Management | Administrative

NEWS UPDATE

GE's Continuing Legal Education Calendar

2000 Calendar

Meeting dates & locations

Today's News

"Inside GE" newsclips

Practice Groups

• Antitrust

• Consumer Law & Policy

• E-Commerce & Information Technology

• Environmental

• Flow Goods/Big Ticket

• Government Business

• Insurance

• Insurance Law & Policy

• Intellectual Property

• International Law and Policy

• Labor & Employment

(b) *Response to Appellant’s argument that Lee fails to teach “a computer readable medium storing programming that causes at least one computer to cause items of legal information to be provided for display to a display device, tabulated by type of legal information”.*

Appellant argued that Lee does not teach providing items of legal information for display “tabulated by type of legal information”. On the contrary, Lee teaches at Fig. 6 a plurality of items of legal information tabulated by type of legal information (i.e. “News”, “Secondary material”).

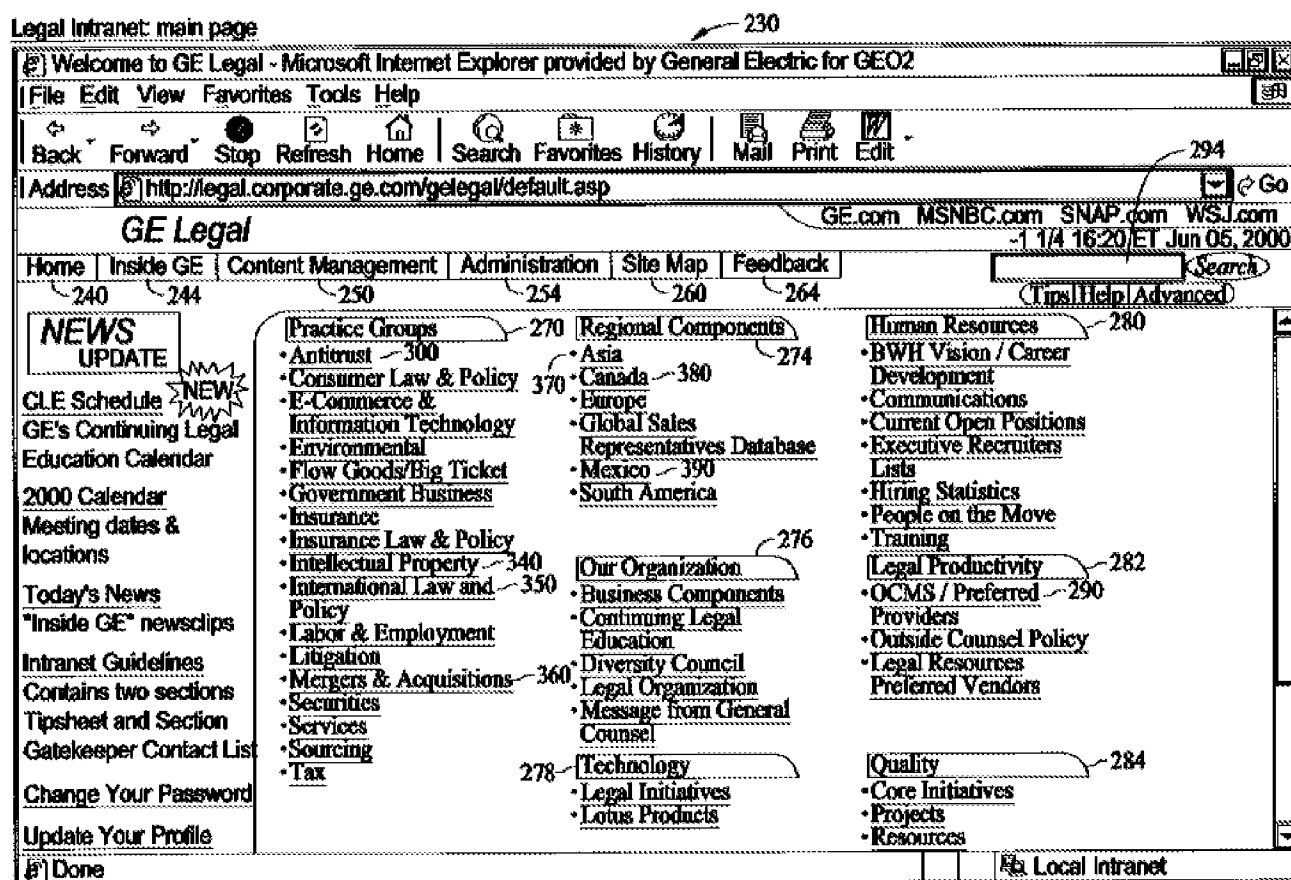


FIG. 6

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Applicant argued that Fig. 6 of Lee depicts a display with entries under the heading "Practice Groups", "Regional Components",... are not "type of legal information" because there is no disclosure in Lee that information in the items under "Practice Group" all relate to the same type of legal information. On the contrary, Lee teaches at Col. 8 lines 25-35 that: "Practice Group 270 is further organized into several different groups such as Antitrust 300, Intellectual Property 340, International Law and Policy 350, and Merges and Acquisitions 360." Therefore, all items of legal information 300, 340, 350, 360 relate to the same type of legal information, which is "Practice Group" 270.

In view of applicant's specification, "type of legal information" refers to different types or classes of information to which the information belongs". Applicant's Fig. 4 shows that legal information items 401, 402, 403 are grouped under different headings such as "Administrative Action" 430, "Current Following" 431, "Security News" 432, which are called "type of legal information" by applicant. However, these headings are simply just labels to identify different class/ category of information items. Similarly, Lee's Fig. 6 organized items of legal information under different groups with different headings in tabulated format, and therefore anticipates the claimed limitation "tabulated by type of legal information".

2. Claims 7-9, 66-67.

Regarding claim 7, Appellant argued that Le does not teach "**automatically access** within any databases new legal information **responsive to a request** while

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items of legal information associated with previously accessed legal information is provided for display on a display device". On the contrary, Lee teaches at Col. 2 lines 7-22 that the LMS "providing up-to-date legal/business information to any user, upon request". Lee's Fig. 6 also display new legal information (i.e "Today's News") concurrently with previously accessed information. When a user click on "Today's News" link, the system will automatically access the database to retrieve new information for the date and display it to the user.

3. Claims 30, 32-35, 69.

Regarding claim 30, Appellant argued that Lee does not teach "assigning at least one identifier to each of a plurality of documents comprising legal information relating to a plurality of legal topics, wherein the at least one identifier is associated with (a) at least one legal topics and (b) at least one of plurality of types of legal information". On the contrary, Lee teaches at Col. 10 lines 34-44 the step of assigning a title (i.e. "identifier") for each document. Lee also teaches at Col. 9 lines 5-20 and Fig. 6 that each document is associated with multi-level logical groups which represent plurality of legal topic (i.e. "Antitrust", "Consumer Law"...) and plurality of types of legal information (i.e. "News", "Practice Group", "Regional Components".)

Applicant further argued that Lee does not teaches "formatting the received document according to a protocol, storing the formatted documents in at least one database". On the contrary Lee teaches at Col. 9 lines 5-10 that document are stored in HTML format, which is a well known format for HTTP protocol.

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In light of the foregoing arguments, the 35 U.S.C 102 rejection is hereby sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Khanh B. Pham/

Primary Examiner

Art Unit 2166

Conferees:

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166

/Eddie C. Lee/

Supervisory Patent Examiner, TC 2100

Eddie Lee

Supervisory Patent Examiner